

**REMARKS****INTRODUCTION:**

In accordance with the foregoing, claims 1 and 23 have been amended. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-18 and 23 are under consideration. Claims 19-22 are withdrawn. Reconsideration is respectfully requested.

**ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:**

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because:

- (a) it is believed that the amendments of claims 1 and 23 put this application into condition for allowance;
- (b) the amendments were not earlier presented because the Applicant believed in good faith that the cited prior art did not disclose the present invention as previously claimed;
- (c) the amendments of claims 1 and 23 should not entail any further search by the Examiner since no new features are being added or no new issues are being raised; and/or
- (d) the amendments place the application at least into a better form for appeal.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

**REJECTION UNDER 35 U.S.C. §112:**

In the Office Action, at page 2, numbered paragraph 2, claim 23 was rejected under 35 U.S.C. §112, second paragraph, for the reasons set forth therein. This rejection is traversed and reconsideration is requested.

Claim 23 has been amended to include "a driving motor to rotate the feed roller part." Hence, amended claim 23 is submitted to be complete and to include all essential structural cooperative relationships of elements.

Thus, amended claim 23 is submitted to be in allowable form under 35 U.S.C. §112,

second paragraph.

**REJECTION UNDER 35 U.S.C. §102:**

In the Office Action, at pages 2--4, numbered paragraph 3, claims 1-2, 4 and 16-17 were rejected under 35 U.S.C. §102(b) as being anticipated by Sata (USPN 5,085,420; hereafter, Sata). This rejection is traversed and reconsideration is requested.

Claim 1 has been amended to show more clearly that the apparatus has a driving motor, wherein during the paper pickup mode, the driving force of the driving motor is not directly transmitted, but indirectly transmitted to the second drive roller only by a contact of the first drive roller with the second drive roller.

It is respectfully submitted that Sata discloses that the separating roller 46, corresponding to the second drive roller of the present invention, directly receives the driving force of the motor 21 and rotates in contact with the feed roller 5 not only when the motor 21 rotates forwards (i.e., line feeding), but also when the motor 21 rotates backward (i.e., paper pickup) (see claims 1, 11, and 13-18 of Sata).

In contrast, in the present invention, the second drive roller 144, 144' directly receives the driving force of the driving motor 155 and rotates in contact with the first drive roller 142, 142' during line feeding, but the second drive roller 144, 144' indirectly receives the driving force of the driving motor 155 during the paper pickup, that is, the second drive roller 144, 144' receives the driving force of the driving motor 155 only by the contact with the first drive roller 142, 142'.

Thus, it is respectfully submitted that independent claim 1 is not anticipated under 35 U.S.C. §102(b) by Sata (USPN 5,085,420). Since claims 2, 4 and 16-17 depend from amended claim 1, claims 2, 4 and 16-17 are not anticipated under 35 U.S.C. §102(b) by Sata (USPN 5,085,420).

**REJECTION UNDER 35 U.S.C. §103:**

In the Office Action, at pages 5-6, numbered paragraph 4, claims 11-12 were rejected under 35 U.S.C. §103(a) as being unpatentable over the Sata patent as applied to claim 1 above, and further in view of Tanaka et al. (USPN 6,024,356; hereafter, Tanaka). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

As noted above, Sata does not teach or suggest a second drive roller that directly receives the driving force of the driving motor and rotates in contact with the first drive roller during line feeding, but the second drive roller indirectly receives the driving force of the driving motor during the paper pickup, that is, the second drive roller receives the driving force of the

driving motor only by the contact with the first drive roller. Thus, Sata does not teach or suggest amended claim 1 of the present invention.

Tanaka recites, col. 6, lines 43-48: "A motor M for paper transport is arranged on one of side plates 18 of a housing H. The housing H has two side plates 18 on its left and right sides but only one of them is illustrated in FIG. 7. The separation roller 12, delivery rollers 19, 21 and 23 and ejection roller 25 are rotated by a drive force from the motor M." Hence, Tanaka also does not teach or suggest amended claim 1 of the present invention.

Thus, even if combined, Sata and Tanaka do not teach or suggest amended claim 1 of the present invention.

Hence, amended claim 1 is submitted to be patentable under 35 U.S.C. §103(a) over the Sata patent, and further in view of Tanaka et al. (USPN 6,024,356), alone or in combination. Since claims 11-12 depend from amended claim 1, claims 11-12 are patentable over the Sata patent, and further in view of Tanaka et al. (USPN 6,024,356), alone or in combination, for at least the reasons that amended claim 1 is patentable over the Sata patent, and further in view of Tanaka et al. (USPN 6,024,356), alone or in combination.

#### **EXAMINER'S RESPONSE TO ARGUMENTS:**

In the Office Action, at pages 6-7, the Examiner provided his response to Applicant's arguments filed 03/09/2006.

Independent claims 1 and 23 have been amended. As noted above, amended independent claims 1 and 23 are submitted to be patentable over the cited references.

#### **ALLOWABLE SUBJECT MATTER:**

In the Office Action, at page 7, claims 3, 5-10, 13-15 and 18 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant thanks the Examiner for his careful review of the claims and determination that claims 3, 5-10, 13-15 and 18 would be allowable if suitably rewritten. However, independent claim 1 has been amended and is submitted to be patentable over the cited art. Hence, since claims 3, 5-10, 13-15 and 18 depend from amended claim 1, claims 3, 5-10, 13-15 and 18 are submitted to be patentable for at least the reasons that amended claim 1 is patentable.

#### **CONCLUSION:**

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all

pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By:

Darleen J. Stockley  
Darleen J. Stockley  
Registration No. 34,257

1201 New York Avenue, N.W.  
Suite 700  
Washington, D.C. 20005  
Telephone: (202) 434-1500  
Facsimile: (202) 434-1501